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UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

SAN JOSE DIVISION

In re ACACIA MEDIA TECHNOLOGIES CORPORATION	Case No. 05-CV-1114 JW MDL No. 1665 **THE SATELLITE DEFENDANTS' NOTICE OF MOTION AND MOTION FOR SUMMARY JUDGMENT OF INVALIDITY OF THE '992, '863, AND '720 PATENTS** Date: TBD Time: TBD Courtroom: 8, 4th Floor Judge: Hon. James Ware

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NOTICE OF MOTION AND STATEMENT OF RELIEF SOUGHT

TO PLAINTIFF AND ITS COUNSEL OF RECORD,

PLEASE TAKE NOTICE that in accordance with the Court's May 27, 2008, Scheduling Order, on a date as soon as the matter may be heard following the date set for the Defendants' reply briefs, Defendants EchoStar Satellite LLC, EchoStar Technologies Corp., and The DIRECTV Group, Inc. (the "Satellite Defendants") will move, and with this motion do move, for summary judgment regarding the validity of U.S. Pat. No. 5,132,992 Claims 41 and 45; U.S. Pat. No. 5,550,863 Claims 17-19; and U.S. Pat. No. 6,002,720 Claim 11.

The grounds for this motion are set forth in the accompanying Memorandum of Points and Authorities, the supporting Declaration of Matthew I. Kreeger, the pleadings of record, and any other fact or argument that may be set forth in subsequent pleadings or in oral argument by counsel. Pursuant to Federal Rule of Civil Procedure 56 and Local Rule 56-1 and for all of the reasons set forth in this motion and supporting Memorandum of Points and Authorities, the Court should render judgment in favor of the Satellite Defendants on the validity of the above patent claims. There is no genuine issue of material fact regarding the invalidity of the above claims, and the Satellite Defendants, as the moving parties, are entitled to judgment as a matter of law.

MEMORANDUM OF POINTS AND AUTHORITIES

I. INTRODUCTION

A patent specification that merely identifies a plan to accomplish an intended result "is an attempt to preempt the future before it has arrived." *Fiers v. Revel*, 984 F.2d 1164, 1171 (Fed. Cir. 1993). Such is the case here. At best, the Yurt patents provide goals for future research, and goals do not describe or enable the claimed systems or methods. Even the experts at the David Sarnoff Research Center — one of the premier engineering research institutions in the United States — concluded in 1992 that the patentees had done nothing more than provide a "starting point for further development" for future video-on-demand systems:

> The patent document supplied by [the Yurt patentees] outlines a generic set of technologies necessary for a video-on-demand system. The general principles of the system described in the patent are believed to be technically correct, *though significant additional design detail will have to be developed before a proof-of-concept prototype can be implemented*. Based on our review of published material (see references) in the area of video-on-demand, interactive multimedia, etc., *we do not consider the overall system architecture to be novel in a scientific/technological sense*. Similar concepts for storing, accessing, transmitting and displaying compressed video and audio information are *widely understood* by researchers in the telecommunication and multimedia fields.

(Ex. A, Sarnoff Report at 2, 3 (emphasis added).[1])[2] *See Automotive Techs. Int'l, Inc. v. BMW of N. Am., Inc.*, 501 F.3d 1274, 1284 (Fed. Cir. 2007) ("The specification provides 'only a starting point, a direction for further research' on using electronic sensors for sensing side impact crashes; it does not provide guidance to a person of ordinary skill in the art on how to make or use an electronic side impact sensor.") (citation omitted).

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[1] During prosecution of the application leading to the '992 patent, in 1992 the Yurt patentees engaged researchers at the David Sarnoff Research Center to review their application. The Sarnoff evaluators concluded that even over a year after filing, the application was not novel and the system was "lacking in specific details particularly at the subsystem level." (Ex. A, Sarnoff Report at 2, 3.)

[2] All exhibits referenced in this motion are attached to the Declaration of Matthew I. Kreeger In Support Of The Satellite Defendants' Motion For Summary Judgment Of Invalidity Of The '992, '863, And '720 Patents.

Patents are the reward for the successful completion of the inventive process, not a benchmark along the way. *Brenner v. Manson*, 383 U.S. 519, 536 (1966) ("[A] patent is not a hunting license. It is not a reward for the search, but compensation for its successful conclusion."). Because the Yurt patents merely provide a "starting point," they are invalid under the written description and enablement requirements. "[A]s part of the quid pro quo of the patent bargain, the applicant's specification must enable one of ordinary skill in the art to practice the full scope of the claimed invention." *AK Steel Corp. v. Sollac*, 344 F.3d 1234, 1244 (Fed. Cir. 2003). The Yurt patents fall far short of this requirement. Neither would one of skill in the art understand that the Yurt patentees invented what they claimed. *See Univ. of Rochester v. G.D. Searle & Co.*, 358 F.3d 916, 928 (Fed. Cir. 2004) (explaining that to satisfy the written description requirement, the patent must "set forth enough detail to allow a person of ordinary skill in the art to understand what is claimed and to recognize that the inventor invented what is claimed.").

Inadequate and non-enabling disclosure, such as that found in the Yurt patents, is the antithesis of a valid patent. Instead of detailing their invention, the Yurt patentees consistently describe the components of their transmission and receiving system by their supposed functions or what the patentees wish the components could do — descriptions that render related claims invalid. *Univ. of Rochester*, 358 F.3d at 923 ("A description of what a material does, rather than of what it is, usually does not suffice. The disclosure must allow one skilled in the art to visualize or recognize the identity of the subject matter purportedly described.") (internal citations omitted). Without an adequate blueprint describing the Yurt patentees' claimed invention, the public is left to speculate as to what the patentees invented and how to practice their purported invention.

Since taking over this case in 2003, this Court has issued six *Markman* orders. At the May 9, 2008, Case Management Conference, the Court authorized the Defendants to submit invalidity motions on the currently asserted claims and issued a May 27 scheduling order for the

Defendants' motions.[3] In accordance with that schedule, the Satellite Defendants request that the Court find the asserted Yurt patent claims invalid on the written description and enablement grounds outlined below. The Satellite Defendants join the Round 3 Defendants' Motions for Summary Judgment Of Invalidity Under 35 U.S.C. § 112 and their Consolidated Brief in Support of Their Motions for Summary Judgment Of Invalidity Under 35 U.S.C. § 112. The Satellite Defendants write separately to address certain issues that pertain to the '720 patent, which is not asserted against any other defendant, as well as additional points related to the Round 3 Defendants' invalidity motions.

II. ARGUMENT

A. Summary Judgment Is Appropriate In A Patent Case.

An issue may be summarily adjudicated when there are no genuine issues of material fact, and the moving party is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(c); *see also Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 247-48 (1986). "[S]ummary judgment . . . is entirely appropriate, in a patent as in any other case." *SRI Int'l v. Matsushita Elec. Corp. of Am.*, 775 F.2d 1107, 1116 (Fed. Cir. 1985) (en banc). Additionally, summary judgment is appropriate on validity issues. *See, e.g., LizardTech, Inc. v. Earth Resource Mapping, Inc.*, 424 F.3d 1336, 1345 (Fed. Cir. 2005) (affirming district court summary judgment of invalidity based on enablement and written description grounds); *Univ. of Rochester*, 358 F.3d at 927 ("[A]lthough compliance with the written description requirement is a question of fact," failure to meet the

[3] Acacia continues to assert the following claims against the Satellite Defendants: U.S. Pat. No. 5,132,992 Claims 41 and 45; U.S. Pat. No. 5,550,863 Claims 17-19; U.S. Pat. No. 6,002,720 Claim 11; and U.S. Pat. No. 6,144,702 Claims 1-8, 11-19, 22, 23, 26-34, and 37-42. In its *Markman II* order the Court found that its constructions of "sequence encoder" and "identification encoder" as indefinite invalidated each of the idependent claims of the '702 patent. (Ex. E, *Markman II* at 18.) Acacia agreed that the claims of the '702 patent were invalid and moved for entry of invalidity and non-infringement. (Doc. No. 120, filed Jan. 20, 2006.) As a result, claim construction proceedings on the '702 patent did not continue. Because the Satellite Defendants were not a party to the initial *Markman* proceedings construing the claims of the '702 patent, they have not brought invalidity motions addressing the asserted claims of the '702 patent, outside of joining the Round 3 Defendants' motions of invalidity based on the constructions of "transmission system" and "receiving system" as those constructions apply to the '702 patent's claims. If further claim construction proceedings become necessary regarding the '702 patent's claims, the Satellite Defendants reserve their rights to bring appropriate invalidity motions.

written description can be shown "based solely on the language of the patent specification"); *Use Techno Corp. v. Kenko USA, Inc.*, 515 F. Supp. 2d 1086, 1099 (N.D. Cal. 2007) (granting motion for summary judgment on enablement grounds); *ICU Med., Inc. v. Alaris Med. Sys.*, No. SA CV 04-689 MRP (VBKx), 2007 U.S. Dist. LEXIS 13157, at *43-44 (C.D. Cal. Feb. 21, 2007) (noting that "[a]lthough the 'written description' inquiry is a question of fact, federal courts often grant or affirm summary judgment of invalidity for lack of a written description" and citing cases).

B. The Asserted Method Claims That Do Not Include A User Request Fail the Written Description Requirement.

The Yurt patentees described their invention as one "in which the user controls the access and the playback operations of selected material." '992 patent, 1:8-10. In particular, the patentees claimed to have invented a new information distribution method "*responsive to requests* identifying information to be sent from a transmission system to a remote location." *Id.* at 2:50-52 (emphasis added). Despite the specification's clear statements that user requests are one of the novel aspects of the claimed distribution method, the patentees nonetheless included method claims (Claims 41 of the '992 patent, 17 of the '863 patent, and 11 of the '720 patent) that do *not* include user requests. Yet, the Yurt patents include *no disclosure* regarding a method of transmitting information independent of a user request. As this Court found:

> Every part of the specification *clearly states an intent* by the inventors that the "transmission system" and the "receiving system" process, store, send and receive the information *specifically in response to "users."*

(Ex. I, *Markman VI* at 4 n.5 (emphasis added).)

Because the Yurt patents do not describe a method of transmitting data independent of a user requesting that data, method Claims 41 of the '992 patent, 17 of the '863 patent, and 11 of the '720 patent fail the written description requirement.

1. To Satisfy the Written Description Requirement A Claim's Breadth Cannot Exceed the Specification's Disclosure.

The Patent Act requires that the patent specification contain "*a written description of the invention*, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art . . . to make and use the same." 35 U.S.C.

§ 112, ¶ 1 (emphasis added). The "written description" clause mandates that the specification "describe the invention sufficiently to convey to a person of skill in the art that the patentee had possession of the claimed invention at the time of application, *i.e.*, that the patentee invented what is claimed." *LizardTech*, 424 F.3d at 1345.

Written description requires that the specification demonstrate "possession" of the claimed invention, and claim breadth therefore cannot exceed the patent's disclosure. *PIN/NIP, Inc. v. Platte Chem. Co.*, 304 F.3d 1235, 1248 (Fed. Cir. 2002) (finding invalid under written description requirement claim to sequential, separate application of two chemicals where the specification only described applying "mixture" of the two chemicals). Thus, the specification must describe *the full scope* of the claimed invention. *LizardTech*, 424 F.3d at 1345 (holding that the written description of one method of achieving the patent's objective did not entitle inventor to claim every method for achieving the objective). By way of example, the Federal Circuit has explained:

> [I]n the nineteenth century, use of the word "automobile" would not have sufficed to describe a newly invented automobile; an inventor would need to describe what an automobile is, viz., a chassis, an engine, seats, wheels on axles, etc. Thus, generalized language may not suffice if it does not convey the detailed identity of an invention.

Univ. of Rochester, 358 F.3d at 923; *see also LizardTech*, 424 F.3d at 1346 (even if specification satisfied § 112, ¶ 1 with respect to a particular fuel-efficient engine, "it would not necessarily support a broad claim to every possible type of fuel-efficient engine, no matter how different in structure or operation from the inventor's engine"). Claims that exceed the scope of the patent's disclosure are invalid for failure to comply with the written description requirement. *LizardTech*, 424 F.3d at 1344-45; *see also Tronzo v. Biomet, Inc.*, 156 F.3d 1154, 1158-60 (Fed. Cir. 1998) (invalidating claims with "non-conical shaped cup" limitation because specification only described conically shaped cups).

The Federal Circuit's *LizardTech* decision is illustrative. *LizardTech* involved a method for creating a seamless discrete wavelet transform (DWT) to compress digital images. *Id.* at 1337. The specification disclosed only one method for creating a seamless DWT, which required "maintaining updated sums of DWT coefficients." *Id*. at 1344. Claim 21, however, lacked the "maintaining updated sums" limitation. *Id*. The court invalidated the claim for lack of written description, refusing to allow the broad claim to encompass all the ways of performing DWT-based compression that lead to a seamless DWT. *Id*. Claim 21 failed to include enough detail "to convince a person of skill in the art that the inventor possessed the invention." *Id*. at 1345. These cases make it clear that patentees may not claim what they fail to describe in the specification.

2. Method Claims In the Yurt Patents Without User Requests Fail the Written Description Requirement.

The Yurt inventors purported to have invented a system and method that relies on a user to select the material to be transmitted to his or her location. According to Acacia's own expert, S. Merrill Weiss, the Yurt patents describe a video-on-demand system that delivers video at the request of users:

> Q: . . . To what extent does the '702 describe a system which would support a system that we would know as video on demand?
>
> A: That is fundamentally what the patent is about.
>
> Q: What is video on demand?
>
> A: Video on demand is a scheme or a system in which content can be delivered, particularly video content, can be delivered to end users or consumers *at their request*.

(Ex. B, 9/8/05 Tr. at 27 (emphasis added).) Similarly, the Sarnoff reviewers concluded that the patents provided "a generic set of technologies necessary for video on demand." (Ex. A, Sarnoff Report at 2.)

The patentees designed their system to improve upon, in their words, "[r]emote accessing of the material," which had not yet been "integrated into an efficient system." '992 patent, 1:16-17. As Acacia explained in its initial *Markman* brief to this Court:

> Today, transmitted digital video is taken for granted. We can view digital video material from many transmission sources, such as the Internet, cable television, and satellite television. Using those sources, *we can now select a movie and watch it at a time of our choosing*, without ever leaving our home.
>
> This was not the case in early 1990. Then, if a person wished to view a selected movie at their home at a time of their choosing, they would have to rent or purchase the movie on videotape or a

> laserdisc. This required one, and sometimes two, trips from the home to the video store. While these methods of viewing movies were accepted and widely used in the United States at that time and now, there remained a pressing, long felt need for a system *which would permit persons to view movies at their homes at a time of their choosing*—without having to leave their homes.

(Ex. C at 1 (emphasis added).)

The Yurt patentees addressed this perceived need by purporting to invent a transmission system, receiving system, and method for distributing material to remote locations in response to selections by end users. ’992 patent, 2:25-3:15. In particular, the patent summarizes the distribution method as “responsive to requests identifying information to be sent from a transmission system to a remote location.” *Id*. at 2:50-52. A user identifies not only the “information to be sent,” but also the remote location where the information will be sent and, optionally, the transmission time. *Id*. at 1:57-2:10; 2:50-61.

The Yurt patent begins by distinguishing the supposed invention from the prior art. *Id*. at 1:18-56. Thus, the Yurt patent tries to demonstrate the supposed novelty of the Yurt invention by contrasting it with the prior art Walter patent, which required users to be at the same remote location for both ordering and viewing of requested material. *Id*. at 1:26-29. The Yurt patent further contrasts the prior art Monslow patent on the ground that it required multiple users to watch a program at the same time rather than allowing individual users to select different viewing times. *Id*. at 1:34-39. Similarly, the Yurt inventors distinguish the Abraham and Lang patents on the ground that they did not allow users to select a viewing time, *id*. at 1:42-44, and did not allow users to select the time or place of playback, *id*. at 1:54-56.

In contrast, the Yurt patentees explained that the advantage of their distribution method was that it allowed users to select the item for transmission, the time it would be played back, and the location of the reception system. *Id*. at 1:58-2:16 (objects of the invention include providing “a user with the capability of accessing audio/video material,” allowing “the user to remotely select audio/video material,” transmitting audio/video material “to any location chosen by the user that has a specified receiver,” allowing a user to play back material “at any time selected by the user,” and allowing a user to select audio material, video material, or both). Without such user requests, the Yurt distribution method *would read on the prior art references* the patent plainly distinguishes. *See LizardTech*, 424 F.3d at 1343-44. ("It would be peculiar for the claims to cover prior art that suffers from precisely the same problems that the specification focuses on solving.").

Consistent with that summary of the invention, the specification is replete with references regarding this selection process *by the user*. Initially, the user accesses the transmission system "by calling a phone number or by typing commands into a computer," after which he "chooses audio and/or video material from a list of available items which he or she wants to listen to and/or watch." '992 patent, 3:55-60. The user chooses the reception system that will receive the transmission and has the option of choosing the playback time. *Id.* at 5:10-14. In this way users would not need to "make a trip to the store to purchase or rent the requested material." *Id.* at 5:31-33.

The patent provides a more detailed description of the various aspects of the distribution method in Figures 3, 4, 5, and 7 and the related discussion in the specification. Figure 7 details the overall distribution method. Transmission is initiated by user "requests identifying information to be sent from the transmission system 100 to remote locations."[4] *Id.* at 18:47-50. Information from the selected items is retrieved from the source material library "upon a request by a user of the distribution system." *Id.* at 18:53-56. The item is then formatted, compressed, and stored in the compressed data library, where it awaits a transmission request. *Id.* at 18:60-19:24. After receiving the transmission request, the compressed, formatted data is converted for output to the reception system "selected by the user." *Id.* at 19:21-24.

Figure 3 further details the remote order processing procedures of the distribution method. First, the user accesses the system, at which point the system confirms that the user is in good standing. *Id.* at 14:3-20. The user then selects the item of information he wants transmitted, the system confirms the selection, and the user then selects "a desired delivery time and delivery location." *Id*. at 14:24-33, 39-40. When the transaction is completed, "the request is placed on a transmission queue at the appropriate compressed data library" to await transmission. *Id*. at 14:45-48. The queue is managed by a program that controls distribution of the requested items by keeping track of such information as the requested location, item ID, delivery time, and the user channel type, as well as managing requests for the same item. *Id*. at 15:33-54.

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[4] The specification's discussion of Figure 7 states that the distribution method is "preferably responsive to [user] requests." '992 patent, 18:47-48. The "preferably" language is meaningless in light of the fact that *no other* embodiments that are not responsive to user requests are described. Even the first step of the distribution method states that items are retrieved from the source material library "upon a request by a user of the distribution system." *Id.* at 18:53-56.

Despite this disclosure, the patents nonetheless include method claims that do *not* have a user request. Because there is no disclosure regarding a distribution method that does not include user requests, any claim that does not include such requests is not supported by the specification. Like the invalid claims in *LizardTech*, *Tronzo*, and *University of Rochester*, method claims without user requests are simply beyond the scope of the disclosure. Just as the patentees in *LizardTech* were not entitled to broad claims that read on all types of seamless discrete wavelet transforms where the specification only described one particular transform, so too is Acacia not entitled to claims that cover methods for transmitting data where its patents have only described transmissions responsive to user requests. *See LizardTech*, 424 F.3d at 1344-45.

For all these reasons, method claims 41 of the '992 patent, 17 of the '863 patent, and 11 of the '720 patent — none of which include user requests — are invalid for failure to satisfy the written description requirement.[5]

C. The Storing and Retrieving Steps of Claim 41 and the Inputting Step of Claim 17 Fail the Written Description and Enablement Requirements Because the Specification Does Not Disclose the Transmission System Performing Claim Steps.

As detailed above, the Satellite Defendants join the Round 3 Defendants' motion that the Yurt patents do not describe the "transmission system" performing steps in Claims 41 of the '992 patent and 17 of the '863 patent.[6] The Satellite Defendants write separately to provide additional

[5] Dependent Claims 45 of the '992 patent and 18-19 of the '863 patent fail the written description requirement for the same reasons.

[6] Dependent Claims 45 of the '992 patent and 18-19 of the '863 patent fail the written description requirement for the same reasons.

reasons why the “storing,” “retrieving,” and “inputting” steps of these claims fail the written description and enablement requirements.

1. The Steps of Claim 41 and Claim 17 Must Be Performed by the “Transmission System.”

The “transmission system” of the Yurt patents must perform the steps of Claims 41 of the ’992 patent and 17 of the ’863 patent. Claim 41 is directed to a method for transmitting information to remote locations that, pursuant to its preamble, must be “performed by a transmission system.” The Court’s *Markman III* order found that the preamble limited the claimed method to one in which “the method of transmitting information must be performed by a ‘transmission system,’ capable of performing the method.” (Ex. F, *Markman III* at 29.) Similarly, the formatting steps of Claim 17 of the ’863 patent must also be performed by the “transmission system.” (Ex. J, 7/21/2006 Parties’ Stip. Def. for Claim Terms from the ’863 and ’720 Patents at 3.)[7] Both claims therefore require that a transmission system perform the claim steps.

Because the specification does not describe a transmission system performing specified steps of Claims 41 and 17, as outlined below, both claims fail the written description and enablement requirements.

2. The “Storing” Step of Claim 41 Is Not Described Because the Patent Does Not Disclose a “Transmission System” Retaining Physical Items.

The first step of Claim 41 requires the “transmission system” to store “items having information in a source material library.” Claim 41 fails the written description requirement with respect to this step because the specification does not describe the transmission system retaining physical items.

The Court initially construed “storing” to require that the “transmission system” “place” physical items into the source material library. (Ex. F, *Markman III* at 30.) Acacia objected to the Court’s “place” construction and instead proposed that “storing” meant that the items were

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[7] Specifically, the “inputting,” “assigning,” “formatting,” and “compressing” steps in Claim 17 “are performed by the transmission system.” (*Id*.)

"retained." (Ex. K, 5/18/2007 Acacia MPA In Support of Mot. for Reconsideration at 20-24.) In the end, the Court modified its original construction and construed the "storing" step to mean:

> an act performed by the "transmission system" of retaining physical items containing audio information or video information or both as a collection of original sources of information in the source material library.

(Ex. H, *Markman V* at 17.)

According to Acacia's expert, Mr. Weiss, the act of "retaining" physical media "requires active maintenance in order to avoid deterioration of the material." (Ex. L, Weiss Decl. ISO Mot. for Reconsideration at 6.) This maintenance connotes numerous storage functions. (*Id.*) For example, Mr. Weiss stated that one of ordinary skill in the art would read "storing" in the context of the Yurt patents to mean that the transmission system controls the "temperature and humidity" where digital media is kept, or uses "robotic machinery to load and unload the media." (*Id.*) Alternatively, Mr. Weiss said the term refers to "keeping power on the memory devices and continually refreshing them through a combination of pulses," or "the periodic movement of copies of the content from one medium to another" as the older medium reaches the end of its useful life. (*Id.*)

The specification, however, describes *none of these functions*. It does not describe what performs the "retaining" act or how the physical items are "retained" in the source material library. There is no mention of "robotic machinery" loading or unloading the media, periodic movement of the content to different mediums, or *any* of the other functions Mr. Weiss attributes to the term.

As the Court explained, "*[t]he specification is silent* as to what component of the 'transmission system' is capable of performing the 'retaining' step." (Ex. H, *Markman V* at 17 n.17.) An analysis of the specification confirms the Court's observation since the specification never describes how the transmission system could "retain" or "store" physical items in the source material library. It states only that the "transmission system" includes a "source material library" and that the "source material library" "includes" various items described in the specification. *See, e.g.,* '992 patent, 5:66-6:2 ("Transmission system 100 of a preferred embodiment of the present invention preferably *includes* source material library means for temporary storage of items prior to conversion and storage in a compressed data library."), 6:10-15 ("The source material library 111 may *include* different types of materials including television programs, movies, audio recordings, still pictures, files, books, computer tapes, computer disks, documents of various sorts, musical instruments, and other physical objects."), 6:23-26 ("The source material library 111 . . . may preferably *include* a single source material library or a plurality of source material libraries.") (all emphasis added). As the Court concluded, "the 'source material library' is *only* described as containing a collection of items having information." (Ex. H, *Markman V* at 17 n.17 (emphasis added); *see also* Ex. G, *Markman IV* at 23 ("Every reference in the written description to the source material library states that it 'includes' audio/video materials.").)

There is no description that would lead someone of ordinary skill in the art to conclude that the patentees described an invention where physical items are actively "retained" in a library or that the patentees possessed such technology. *See LizardTech*, 424 F.3d at 1345 (explaining that written description requirement requires the patentee to "describe the invention sufficiently to convey to a person of skill in the art that the patentee had possession of the claimed invention at the time of application, *i.e.*, that the patentee invented what is claimed.").

Further highlighting this lack of description is Claim 41's requirement that the "transmission system" perform each step of the claim. If the specification lacks any description of retaining physical items in a source material library, it is necessarily devoid of any reference to the "transmission system" performing this step. The specification never describes the components of a transmission system that would actively retain physical items nor does it suggest what such a system would look like.

The claim's requirement that the transmission system perform its steps presents the overreaching that the written description requirement is supposed to prevent — precluding patentees from later claiming that which they did not initially invent. *See Amgen, Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1330 (Fed. Cir. 2003). Claim 41 was *not* part of the applicants' original application. It was originally included in an October 1991 Amendment. (Ex.

M at 11.) In addition, as originally filed, the Yurt patentees did not claim a transmission system that performed the steps of Claim 41. The Yurt patentees only included the limitation that the transmission system perform Claim 41's steps in a later-filed amendment. (Ex. N, 12/26/1991 Amendment at 5.) If later-added limitations are not adequately described in the original application, the claims are invalid for failure to satisfy the written description requirement. *See, e.g.*, *PIN/NIP*, 304 F.3d at 1247-48. Such is the case with Claim 41. Its later-added requirements for the "transmission system" are not supported by the patent's disclosure. Therefore, it is invalid for failure to meet the written description requirement.

3. The "Retrieving" Step of Claim 41 Fails the Written Description and Enablement Requirements Because the Specification Does Not Explain How the Transmission System Gets Information Back From the Physical Items In the Source Material Library.

Claim 41's second step requires that the "transmission system" "retriev[e] the information in the items from the source material library." The only reference to *any* component that might be expected to perform the retrieving step is the specification's reference to the "identification encoder 112." '992 patent, 2:30-33. Because the specification does not teach how the identification encoder, or any other component of the transmission system, performs the retrieving step or how the transmission system retrieves *any* information from physical items containing audio or video information, it fails both the written description and enablement requirements.

As required by the Court's *Markman III* order, the transmission system must be capable of retrieving information from the physical items.[8] (Ex. F, *Markman III* at 29.) How this might occur is never disclosed in the specification. In Figure 2a, the identification encoder is shown as a box connected to the source material library. A single arrow flows from the source material library into the identification encoder. But what is sent from the source material library — whether physical items or information in those items — the specification never says. The

[8] The Court construed the term "retrieve" to mean "to get something back." (Ex. D, *Markman I* at 13.) In the context of Claim 1 of the '992 patent, the Court construed the "retrieving" function of the "identification encoding means" to be "to get back the information that is contained in the items which are stored in the source material library." (*Id.*)

specification further suggests that the identification encoder is responsible for inputting the retrieved digital signal from the items into the "digital input receiver 124" and the retrieved analog signal from the items into the "analog input receiver 127." '992 patent, 6:55-68. But as this Court has repeatedly found, the specification's description of the "identification encoder" amounts to a black box that does not identify whether the device is software, hardware, or some combination of the two.

> [T]he references to block 112 in the specification do not assist the Court in defining what an "identification encoder" is. All that the specification does is to describe what the "identification encoder" preferably must do. The specification does not disclose a circuit, a computer operating a software algorithm, or other apparatus which performs the functions designated for the "identification encoder."

(Ex. E, *Markman II* at 16-17 (emphasis in original).) Without additional disclosure, "one of ordinary skill in the art would not understand the scope or bounds of the structure of the term 'identification encoder' when that term is read in light of the specification." (*Id.* at 18.)[9] Accordingly, the retrieving step fails the written description requirement.

For similar reasons, the retrieving step fails the enablement requirement. "The purpose of [the enablement requirement] is to assure that the inventor provides sufficient information about the claimed invention that a person of skill in the field of the invention can make and use it without undue experimentation, relying on the patent specification and the knowledge in the art." *Scripps Clinic & Research Found. v. Genentech, Inc.*, 927 F.2d 1565, 1571 (Fed. Cir. 1991). It dictates that the specification must teach those of skill in the art how to use and make "the full scope of the claimed invention." *In re Wright*, 999 F.2d 1557, 1561 (Fed. Cir. 1993); *see also In re Vaeck*, 947 F.2d 488, 496 (Fed. Cir. 1991) (requiring specification to "teach those of ordinary skill how to make and how to use the invention as broadly as it is claimed").

Here, as the Court found, one of ordinary skill in the art would have no way of knowing how to make or design an identification encoder — the only component disclosed in the patent for retrieving information from the physical items. As Acacia's expert, Mr. Weiss, testified, outside of storage devices, low level compression systems, general computers, and time encoders, one of skill in the art could not purchase specific components of the Yurt transmission system, and the remaining subsystem components disclosed by the patents would have to be "customized to work together in the system." (Ex. B, 9/8/2005 Tr. at 52-53.) Regarding the identification encoder specifically, he testified:

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[9] The specification states that "retrieving the information for selected items in the source material library" is "analogous to taking books off of a shelf at the local public library." '992 patent, 18:53-59. Plainly, this analogy fails to provide any disclosure of a system of interconnected parts that performs the retrieval step.

> I think I said yesterday that the system would need to be designed very specifically for an application, and I talked yesterday about the scope of the identifier, for instance. The characteristics of the system would lead to different specific designs, I believe, of the identification encoder. But the fundamental functions that are required are defined in the patent.

(Ex. B, 9/9/2005 Tr. at 246-47.) In other words, different engineers would have to specifically design the identification encoder according to the needs of their particular system, which would lead to any number of different results. And, according to Mr. Weiss, the guidance offered by the patent is limited to the component's functions. This limited guidance does not meet the enablement requirement. *See In re Ghiron*, 442 F.2d 985, 991 (C.C.P.A. 1971) ("If . . . practice [of a method claim] requires [a] particular apparatus, . . . it is axiomatic that the application must . . . provide a sufficient disclosure of that apparatus if such is not already available.");[10] *see also Automotive Techs.*, 501 F.3d at 1283 ("Given that the novel aspect of the invention is side impact sensors, it is insufficient to merely state that known technologies can be used to create an electronic sensor.").

In short, the patent's lack of disclosure would force one of ordinary skill in the art to begin from scratch in developing an apparatus that is both part of a transmission system and capable of getting back information contained in the physical items. For all of these reasons, Claim 41's retrieving step fails the written description and enablement requirements.

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[10] In *Ghiron* the applicants defined the performance of a method claim by the related components' functions using block diagrams. Like here, however, the claimed method required that skilled artisans modify existing general purpose computers to carry out the method; modifications that themselves required "complex assemblages that [could] have widely differing characteristics." *Id*. at 991-92. Moreover, "[t]he lines interconnecting the rectangles of appellants' drawings [did] not represent electrical conductors but merely indicate[d] the routing of intangible data or information between functional modules." *Id*. at 992. Accordingly, the court agreed with the PTO that the claim was not enabled. *Id*.

4. Claim 17 Fails the Written Description and Enablement Requirements Because the Patent Does Not Describe the Transmission System Putting Physical Items Into the Transmission System.

Claim 17's first formatting step provides: "inputting an item having information into the transmission system." The Court has construed this phrase to mean "putting physical items containing audio information or video information or both into the transmission system." (Ex. G, *Markman IV* at 12.) Because the specification contains no disclosure regarding how the transmission system puts physical items into the source material library, Claim 17 fails to meet the written description and enablement requirements.

As outlined above, the specification refers to physical items that are contained in the source material library. '992 patent, 6:2-19. But it never describes how these physical items got there or how the transmission system would perform this step — a conclusion the Court has already reached twice before. In its *Markman V* order, the Court reexamined its construction of the "storing" step of Claim 41 of the '992 patent. In so doing, it found that "the specification does not contain *any description* of how the transmission system places items into the system." (Ex. H, *Markman V* at 16 (emphasis added).) Similarly, the Court concluded in its *Markman IV* order that "the written description is *devoid of any discussion* of an apparatus or process for 'inputting' those items into the source material library. The written description contains neither a discussion of the source material library performing the function of inputting physical items nor is there any discussion of an apparatus linked to the source material library which inputs items into it." (Ex. G, *Markman IV* at 23 (emphasis added).)

The Court's conclusion is clearly correct since the specification does not refer to how physical items are placed inside the source material library. The descriptions of the transmission system, and specifically its source material library, begin with the physical items already inside the library. *See, e.g.*, '992 patent, 6:8-34, 18:53-59, Fig. 2b. As the Court explained, the specification only discloses that the source material library "'includes' audio/video materials.

There is *never a discussion* of a structure to place media into the source material library." (Ex. G, *Markman IV* at 23 (emphasis added).)

On this latter point, even Acacia agrees. At the August 2007 reconsideration hearing, Acacia's counsel repeatedly argued that the specification never discloses how items get into the source material library:

> Mr. Dorman: . . . So we're talking about [a] distribution method [in Claim 41]. If we go to Figure 7, and if we go to figure 7 in the patent, which is beside figure 5, it starts "retrieve" at the very top. The first [step] is retrieving. *So there's no discussion about how, how information gets placed into a source material library*. If we go to figure 2(a) that talks about, about the transmission system, look at the far left side of that. *There's no arrow going into source material library. Source material library is where things start from.* This transmission system speaks of, of only things being maintained there that are retrieved from it. There's no arrow going in there.
>
> And indeed if we go to column 5, to the paragraph at the bottom of column 5 where we're talking about the source material library it says figures 2(a) and 2(b) illustrate . . . the transmission system 100 of a preferred embodiment of the present invention preferably includes source material library means for temporary storage of items prior to conversion. So this is a description of the transmission system that is, that is — *all that is being disclosed isn't that, as how things are being stored or put in. It's just that they're there*. They're available. They're holding them.

(Ex. O, 8/17/2007 Tr. at 202-03 (emphasis added).) Thus, according to Acacia's view of the patent's disclosure, nothing in the specification describes how the items are "put into" the source material library.

Without *any* description regarding how the physical items are input into the source material library, no one of ordinary skill in the art would recognize that the Yurt patentees "possessed" such an invention. Moreover, skilled artisans would be left to determine alone how to develop an interconnected system that puts physical items into some kind of storage device before retrieving and converting the data contained on the physical media into the required inputs of the system. Similarly, they would be left to determine whether any of the necessary components were hardware, software, or some combination of the two.

Accordingly, Claim 17 fails the written description requirement. *Univ. of Rochester*, 358 F.3d at 922-23 ("[While] claimed subject matter 'need not be described in haec verba' in the specification to satisfy the written description requirement, it is also true that the requirement must still be met in some way so as to 'describe the claimed invention so that one skilled in the art can recognize what is claimed.'") (citations omitted). For the same reasons, Claim 17 also fails the enablement requirement. *LizardTech*, 424 F.3d at 1345. In other words, where the specification fails to disclose *any* structure or description regarding how one of skill in the art would make or use a claim, the claim is not enabled. *Automotive Techs.*, 501 F.3d at 1285; *LizardTech*, 424 F.3d at 1344-46. For all these reasons, Claim 17 is invalid.

D. Claim 11 of the '720 Patent is Invalid Because the Specification Does Not Describe or Enable Subscribers To Designate Individual Receiving Devices.

As discussed above, the Yurt patents repeatedly emphasize a user's ability to choose an item for transmission, as well as the location and time that the information will be played back. '992 patent, 1:57-2:10; 2:49-61. Claim 11 of the '720 patent introduces an additional aspect of user selectability: the ability to choose the receiving device or devices to which the transmissions will be sent. Because the specification does not describe how subscribers can designate specific receiving stations, what the devices are, or how one of skill in the art would design and make such devices, Claim 11 fails both the written description and enablement requirements.

Claim 11 of the '720 patent is directed to a method of transmitting information to "subscriber selectable receiving stations." The information is initially formatted and compressed at a "central processing location" and then sent to a "local distribution system," where the data is stored. The "local distribution system" then sends the stored information to "subscriber selectable receiving stations." The Court construed "local distribution system" to mean a "reception system . . . located geographically close" to the subscriber stations. (Ex. G, *Markman IV* at 8.) Because there is no disclosure of a reception system communicating to another reception system, the Court found that a subscriber receiving station must be something different from a reception system. (*Id*. at 10.) Accordingly, the Court found that a "subscriber selectable receiving station" referred to a "receiving device," broadly construing the term to mean "receiving device or devices which can be designated by the subscriber." (*Id*. at 15.)

The description of how subscribers designate "subscriber selectable receiving stations" is acutely lacking. Even the engineers that the applicants engaged from the Sarnoff Research Center concluded that the patent's disclosure did little more than present a beginning point for additional research: "The present document does contain some new material related to . . . the subscriber receiver, and *it is possible that these ideas could be further developed* into more detailed patents, working prototypes, or products." (Ex. A, Sarnoff Report at 2 (emphasis added).) In other words, without more detail the applicants did little more than provide a baseline for future development.

In particular, the patent does not disclose how the user selects from among receiving stations, which are apparently integrated in some undisclosed way within a distributed transmission system involving a "central processing location" and "local distribution system."[11] The term "subscriber selectable receiving stations" is *never even used in the specification* and, unlike other components given passing reference by the patentees, the specification does not attribute a box to the "subscriber selectable receiving stations."[12] Any discussion regarding a method of users selecting from among subscriber receiving stations or of the "central processing location" or "local distribution system" providing that choice is similarly absent. Instead, the "subscriber selectable receiving stations" are another of the components on the Yurt patentees' wish list; components whose descriptions are limited to their function — in this case selecting between receiving stations — rather than any detailed identity of what the stations are or how they, or the "central processing location" or "local distribution system," accomplish the selecting function. *See Univ. of Rochester*, 358 F.3d at 923 ("[G]eneralized language may not suffice if it does not convey the *detailed identity* of an invention.") (emphasis added).

The inadequate disclosure is despite the fact that "subscriber selectablility" was, according to the patentees, the novel aspect of Claim 11. For example, during prosecution the Examiner

[11] Neither "central processing location" nor "local distribution system" is used in the specification either.

[12] The term "subscriber selectable receiving stations" was used for the first time in the '720 patent, which was filed over five years after the applicants filed the original application leading to the '992 patent.

rejected what would eventually become Claim 11 in light of the Hoarty patent. The *only* distinction between their application and Hoarty asserted by the applicants was the fact that Hoarty "does not allow the user to select another premises or a subscriber *selectable* receiving station to which information is transmitted." (Ex. P, 6/7/1999 Reply and Amendment at 8 (emphasis in original).) In other words, Claim 11 allowed the user to choose a remote location, *as well as* "designate" a particular receiving station. How the patentees envisioned solving this perceived shortcoming regarding selecting particular receiving stations is not disclosed. The specification does not describe what the "subscriber selectable receiving stations" are or how they, or anything else, allow subscribers to choose a particular device to receive transmissions from the "local distribution system."

The term "receiving device" is only used twice in the patent, and in neither case does the patent disclose anything beyond what the patentees want the device to do. The first reference to the term is an attempt to make some vague connection between the "communications controller," which is also not described, the reception system, and the subscriber's receiving device:

> After availability is confirmed in step 5010, the communications controller preferably makes the physical connection to the reception system 200 of the user (step 5020). This is normally done by dialing the receiving device of the user. The reception system 200 preferably answers the incoming call and confirms the connection (step 5030).[13]

'992 patent, 16:38-44. In the second reference the patentees purport to attribute VCR-like functions to the subscriber's receiving device. *Id.* at 18:38-41 ("By using the reception system 200 of the present invention, the user may utilize the stop, pause, and multiple viewing functions of the receiving device.").

How a "receiving device" could possibly allow a user to choose the device or devices to which the "local distribution system" will transmit information is simply left to the imagination of

[13] This reference itself is nonsensical. The patent does not explain how the reception system, which, in Claim 11, is located at the "local distribution system," is capable of answering an incoming call from the "communications controller" to the user's "receiving device." The reference makes even less sense considering that in Claim 11 the "subscriber selectable receiving stations," or receiving devices, are geographically separate from the "local distribution system."

the reader. The patent *never* mentions designating a receiving device from among different receiving devices, let alone describes how receiving devices, the "central processing location," or the "local distribution system" are supposed to be capable of performing this function. Indeed, the patent does not even disclose what a "receiving device" is, limiting the description to its purported functions of connecting with the communications controller/reception system and creating VCR-like options. And, as with numerous other components, the specification is silent as to whether the receiving device is hardware, software, or some combination of the two.

In addition, the patent's limited disclosure does not describe or enable the full scope of the claimed "subscriber selectable receiving stations." *See LizardTech*, 424 F.3d at 1344-45; *see also Tronzo*, 156 F.3d at 1158-60. The Yurt patentees purport to have designed a transmission and reception system and distribution method that operates "with any available communication channels," including satellite, cable, ISDN, microwave, and traditional broadcast television. '992 patent, 15:66-67, 16:4-15. But the patent never discloses a "selectable receiving station" or "receiving device" that would allow a subscriber to designate "receiving devices" across or within different communication channels or even operate using each or any of these transmission mediums. Whether the devices are (or include) modems, satellite receiving dishes, cable set-top boxes, broadcast antennas, or related devices, the specification does not say. *See In re Ghiron*, 442 F.2d at 991 ("If . . . practice [of a method claim] requires [a] particular apparatus, . . . it is axiomatic that the application must . . . provide a sufficient disclosure of that apparatus if such is not already available.").

Neither is there any mention regarding how the transmission and/or reception systems communicate the user's designation to the selected receiving device (or devices) or what sort of channels are used to communicate such choices. Nor does the specification disclose the necessary circuitry that would allow a user to designate such a device, where such circuitry would be located, or how such circuitry would be interconnected with the "central processing location" or "local distribution system" so as to allow the subscriber to choose between devices. *Compare Automotive Techs*., 501 F.3d at 1283 ("Noticeably absent is any discussion of the circuitry involved in the electronic side impact sensor that would provide more detail on how the sensor operates. The mere boxed figure of the electronic sensor and the few lines of description fail to apprise one of ordinary skill how to make and use the electronic sensor.”).

Nothing in the specification would covey to a skilled artisan that the Yurt patentees “possessed” technology capable of allowing subscribers to designate receiving devices as they choose. *See PIN/NIP*, 304 F.3d at 1248. Moreover, with respect to the written description requirement, the issue is *not* “whether one of skilled in the art might be able to construct the patentee’s device from the teachings of the disclosure of the application. Rather, it is a question whether the application necessarily discloses that particular device.” *Univ. of Rochester*, 358 F.3d at 923 (quotation omitted). With the disclosure of the “subscriber selectable receiving stations” being limited to their function, Claim 11 is invalid for failure to satisfy the written description requirement. *See id*. at 923 (“A description of what a material does, rather than of what it is, usually does not suffice. The disclosure must allow one skilled in the art to visualize or recognize the identity of the subject matter purportedly described.”) (citation omitted).

For the same reasons, Claim 11 also fails the enablement requirement. Acacia cannot point to the knowledge of one of skill in the art to fill in the disclosure’s enabling gaps. “The scope of enablement . . . is that which is disclosed in the specification plus the scope of what would be known to one of ordinary skill in the art without undue experimentation.” *Nat’l Recovery Techs., Inc. v. Magnetic Separation Sys., Inc.*, 166 F.3d 1190, 1196 (Fed. Cir. 1999). However, as the Federal Circuit has held:

> “It is the specification, not the knowledge of one skilled in the art, that must supply the novel aspects of an invention in order to constitute adequate enablement.” Although the knowledge of one skilled in the art is indeed relevant, *the novel aspect of an invention must be enabled in the patent*.

Automotive Techs., 501 F.3d at 1283 (quoting *Genentech, Inc. v. Novo Nordisk A/S*, 108 F.3d 1361, 1366 (Fed. Cir. 1997) (emphasis added)). In other words, “the rule that a specification need not disclose what is well known in the art is ‘merely a rule of supplementation, not a substitute for a basic enabling disclosure.’” *Id*. (quoting *Genentech*, 108 F.3d at 1366). The same is true here. Acacia cannot rely on the knowledge of an expert to provide disclosure on the novel feature — a feature that was the basis for distinguishing the Hoarty reference — of what the patentees considered to be their invention where the specification is lacking such description.

The specification makes clear that the patentees considered the user's ability to choose or designate a specific receiving station to be the key point of novelty that distinguished Claim 11 from the prior art. Because the specification has *no* disclosure regarding what such devices are or how they would operate in an interconnected transmission and reception system, Claim 11 is also invalid for failure to satisfy the enablement requirement. *See Genentech*, 108 F.3d at 1366 ("Patent protection is granted in return for an enabling disclosure of an invention, not for vague intimations of general ideas that may or may not be workable . . . . Tossing out the mere germ of an idea does not constitute enabling disclosure.").

For all of these reasons, Claim 11 is invalid.

III. CONCLUSION

For all the above reasons, the Satellite Defendants request that the Court find that Claims 41 and 45 of the '992 patent, 17-19 of the '863 patent, and 11 of the '720 patent fail the written description and enablement requirements as described above.

Respectfully submitted,

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ECF CERTIFICATION

Pursuant to General Order No. 45, § X.B., the filing attorney attests that she has obtained concurrence regarding the filing of this document from the other signatory to the document.